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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Robert S. Silverman

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PATENTMETRIX  
14252 CULVER DR. BOX 914  
IRVINE, CA 92604

EXAMINER

BATTULA, PRADEEP CHOUDARY

ART UNIT

PAPER NUMBER

3722

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/534,448	<b>Applicant(s)</b> SILVERMAN, ROBERT S.	
	<b>Examiner</b> PRADEEP C. BATTULA	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30-43,45-57 and 115-120 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-43,45-57 and 115-120 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/28/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

**This action is in reply to the response filed on December 28, 2007**

### ***Information Disclosure Statement***

The information disclosure statement filed on December 28, 2007 has been considered, however, the relevance to of some of the references pertaining to security, software, and fireman training is not clear to the Examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 30 – 33, 40 – 43, 45 – 47, 49, 50, 54 – 57, 115, 116, 118, and 119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldonado in view of Reynolds (U.S. 193,036).

In regards to Claims 30, 31, 41, 115 and 118, Maldonado discloses a book cover 10 (Column 2, Lines 22 – 23) formed from an elastomeric polymer material 101 (Column 2, Lines 25 – 31; Figure 4a, Item 101), comprising: an outside surface adapted to generally cover the exterior surfaces of a book 11 (Figure 1, Items 10, 11); and pocket portions 140, 141 adapted to receive at least a portion of the covers of the book (Column 3, Lines 10 – 17; Figure 3, Items 140, 141) wherein the cover is substantially of uniform thickness (Column 2, Lines 40 – 46; Figure 3).

Maldonado does not disclose wherein each pocket portions comprises a generally elliptically-shaped access slot having a top peripheral edge and a bottom peripheral edge, wherein the top peripheral edge of the generally elliptically-shaped access slot of the first pocket portion is attached to the top peripheral edge of the generally elliptically-shaped access slot of the second pocket portion, and wherein the bottom peripheral edge of the generally elliptically-shaped access slot of the first pocket portion is attached to the bottom peripheral edge of the generally elliptically-shaped access slot of the second pocket portion.

Reynolds discloses a book cover with pocket portions g and g' wherein each pocket portions (Figure 1) at parallel sides comprising a generally elliptically-shaped access slot (Figure 1, Items g, g') having a top peripheral edge and a bottom peripheral edge (Figure 1), wherein the top peripheral edge of the generally elliptically-shaped access slot of the first pocket portion is attached to the top peripheral edge of the generally elliptically-shaped access slot of the second pocket portion (Page 2, Column 1, Paragraph 4), and wherein the bottom peripheral edge of the generally elliptically-shaped access slot of the first pocket portion is attached to the bottom peripheral edge of the generally elliptically-shaped access slot of the second pocket portion (Page 2, Column 1, Paragraph 4; the pocket is made from a folded over portion). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the pockets of Maldonado with elliptical shaped access slots wherein top and bottom peripheral edges are connected to one another in order to

provide a cover that fully encases the covers of a book and also allows for easy insertion of the covers.

In regards to Claim 32, as applied to Claim 30, Maldonado modified by Reynolds further discloses wherein the pocket portions are adapted to receive of the covers of the book (Column 3, Lines 25 – 26; Maldonado).

In regards to Claim 33, as applied to Claim 30, Maldonado modified by Reynolds further discloses wherein periphery edges (104 –107) of the book cover are reinforced 110 (Column 2, Lines 47 – 50; Figures 4a & 5, Item 110; Maldonado).

In regards to Claim 40, as applied to Claim 30, (wherein Maldonado modified by Reynolds meets the structural limitations) and with respect to the book cover being molded; even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

In regards to Claim 42, as applied to Claim 30, Maldonado modified by Reynolds further discloses wherein peripheral edge (Examiner considers the peripheral edge anything outside of the non uniform thickness) portions of the book cover have at least one groove adapted to secure the book cover around the book perimeter (Figure 5, pinched ends help form a groove to receive the book; Maldonado).

In regards to Claim 43, as applied to Claim 42, Maldonado modified by Reynolds further discloses wherein the elastomeric material (Maldonado) is selected from the group consisting of rubbers and latex (it is well known that neoprene is a type of synthetic rubber). It is also known that silicone rubber and latex are also synthetic rubbers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Maldonado with a different synthetic rubber, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

In regards to Claim 45, 50, and 56 as applied to Claim 30, Maldonado modified by Reynolds further discloses wherein the book cover includes at least one visual effect (Examiner considers a visual effect to also be an item of color or indicia since they make the item stand out; Figure 1; Maldonado).

In regards to Claim 46, as applied to Claim 45, Maldonado modified by Reynolds further discloses wherein the book cover is colored (Column 2, Lines 56 – 68).

In regards to Claims 47 and 49, as applied to Claim 45, Maldonado modified by Reynolds further discloses a multi material cover having multi colors (Column 2, Lines 56 – 68; Maldonado) and due to the colors the cover is opaque.

In regards to Claims 54 and 55, as applied to Claim 30, Maldonado modified by Reynolds further discloses wherein at least one surface of the book cover is textured considering the periphery is stitched and at a different level (Column 2, Lines 64 – 65; Figure 5; Maldonado) where both would help with gripping.

In regards to Claim 57, as applied to Claim 30, Maldonado modified by Reynolds further discloses wherein the book cover is waterproof (Column 1, Lines 20 – 25; Column 2, Lines 25 – 31).

In regards to Claim 116 and 119, as applied to Claim 115 and 117, Maldonado modified by Reynolds further discloses wherein the elastomeric material (Maldonado) is selected from the group consisting of rubbers and latex (it is well known that neoprene is a type of synthetic rubber). It is also known that silicone rubber and latex are also synthetic rubbers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Maldonado with a different synthetic rubber, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

2. Claims 34, 35, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldonado (U.S. 5,013,068) in view of Reynolds (U.S. 193,093) and Wong et al. (Wong; U.S. Pub. 2004/0066031).

In regards to Claim 34, as applied to Claim 33, Maldonado modified by Reynolds does not disclose wherein said periphery edges are reinforced by the material of the book cover being thicker thereat.

Wong discloses of reinforcement members, in an item to hold signatures wherein the reinforcement members are made from the original material of the object (Page 2, Column 1, Lines 1 – 6). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to obtain a reinforcing

perimeter as taught by Wong in order to further strengthen the reinforcing methods of Maldonado in view of Reynolds (Page 2, Column 1, Lines 1 – 6; Wong).

In regards to Claim 35, as applied Claim 34, Maldonado modified by Reynolds and Wong further discloses wherein said periphery edges are at least twice as thick as unreinforced portions of the book cover (Page 2, Column 1, Lines 1 – 6; Wong).

3. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maldonado in view of Reynolds and Peker.

In regards to Claim 36, as applied to Claim 30, Maldonado modified by Reynolds does not disclose wherein edge portions of the access slot are reinforced.

Peker discloses a book cover 4 where pockets 12 and 14 are reinforced (Column 5, Lines 5 – 23). Therefore it would have been obvious to a person having ordinary skill in the art to provide a stitched material (as shown by Maldonado along periphery) in order to protect and reinforce the pockets adapted to receive the book covers.

4. Claim 37 and 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Maldonado in view of Reynolds, Peker, and Wong.

In regards to Claim 37, as applied to Claim 36, Maldonado modified by Reynolds and Peker does not disclose wherein said edge portions are reinforced by the material of the book cover being thicker thereat and wherein said edge portions are at least twice as thick as unreinforced portions of the book cover.

Wong discloses of reinforcement members, in an item to hold signatures wherein the reinforcement members are made from the original material of the object (Page 2, Column 1, Lines 1 – 6). Therefore it would have been obvious to a person



having ordinary skill in the art at the time the invention was made to obtain a reinforcing perimeter, as taught by Wong, and on the pocket area as taught by Reynolds in order to further strengthen the reinforcing methods of Maldonado (Page 2, Column 1, Lines 1 – 6; Wong).

In regards to Claim 38, as applied to Claim 37, Maldonado modified by Reynolds, Peker and Wong further discloses wherein said edge portions are at least twice as thick as unreinforced portions of the book cover (Page 2, Column 1, Lines 1 – 6; Wong).

5. Claims 30, 39, 45, 48, 50, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manning in view of Maldonado and Reynolds.

In regards to Claims 30 and 39, Manning discloses a book cover 10 comprising: an outside surface (Figure 1) and pocket portions 18, 19 (Column 3, Lines 3 – 6; Figure 2, items 18, 19) wherein the book cover is of unitary construction (Column 1, Lines 51 – 55).

Manning does not disclose formed from an elastomeric polymer material an outside surface adapted to generally cover the exterior surfaces of a book and pocket portions adapted to receive at least a portion of the covers of the book and generally elliptically-shaped access slot having a top peripheral edge and a bottom peripheral edge, wherein the top peripheral edge of the generally elliptically-shaped access slot of the first pocket portion is attached to the top peripheral edge of the generally elliptically-shaped access slot of the second pocket portion, and wherein the bottom peripheral edge of the generally elliptically-shaped access slot of the first pocket portion is

attached to the bottom peripheral edge of the generally elliptically-shaped access slot of the second pocket portion.

Maldonado discloses a book cover 10 (Column 2, Lines 22 – 23) formed from an elastomeric polymer material 101 (Column 2, Lines 25 – 31; Figure 4a, Item 101), comprising: an outside surface adapted to generally cover the exterior surfaces of a book 11 (Figure 1, Items 10, 11); and pocket portions 140, 141 adapted to receive at least a portion of the covers of the book (Column 3, Lines 10 – 17; Figure 3, Items 140, 141) wherein the cover is substantially of uniform thickness (Column 2, Lines 40 – 46; Figure 3).

Manning modified by Maldonado does not disclose a generally elliptically-shaped access slot having a top peripheral edge and a bottom peripheral edge, wherein the top peripheral edge of the generally elliptically-shaped access slot of the first pocket portion is attached to the top peripheral edge of the generally elliptically-shaped access slot of the second pocket portion, and wherein the bottom peripheral edge of the generally elliptically-shaped access slot of the first pocket portion is attached to the bottom peripheral edge of the generally elliptically-shaped access slot of the second pocket portion.

Reynolds discloses a book cover with pocket portions g and g' wherein each pocket portions (Figure 1) at parallel sides comprising a generally elliptically-shaped access slot (Figure 1, Items g, g') having a top peripheral edge and a bottom peripheral edge (Figure 1), wherein the top peripheral edge of the generally elliptically-shaped access slot of the first pocket portion is attached to the top peripheral edge of the

generally elliptically-shaped access slot of the second pocket portion (Page 2, Column 1, Paragraph 4), and wherein the bottom peripheral edge of the generally elliptically-shaped access slot of the first pocket portion is attached to the bottom peripheral edge of the generally elliptically-shaped access slot of the second pocket portion (Page 2, Column 1, Paragraph 4; the pocket is made from a folded over portion). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the pockets of Manning with elliptical shaped access slots wherein top and bottom peripheral edges are connected to one another in order to provide a cover that fully encases the inserted elements and also allows for easy insertion of the elements.

In regards to Claim 45, 50, and 56 as applied to Claim 30, Manning modified by Maldonado and Reynolds further discloses wherein the book cover includes at least one visual effect (Examiner considers a visual effect to also be an item of color or indicia since they make the item stand out; Figure 1; Manning & Maldonado).

In regards to Claim 48, as applied to Claim 45, Manning modified by Maldonado and Reynolds further discloses wherein the book cover can be transparent (Column 1, Lines 51 – 59; Manning).

6. Claims 51 – 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manning in view of Maldonado, Reynolds and Contello.

In regards to Claims 51 and 52, as applied to Claim 45, Manning in view of Maldonado and Reynolds does not disclose wherein the book cover contains a plurality

of reflective particles and wherein the reflective particles are suspended in the elastomeric polymer material.

Contello discloses a material comprising light reflective flakes (Column 5, Lines 42 – 48). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the cover of Manning modified by Maldonado and Reynolds with the reflective flakes of Contello in order to provide a book cover with a necessary safety feature (Column 5, Lines 48 – 53 – Contello; Column 2, Lines 64 – 68 – Maldonado).

In regards to Claim 53, as applied to Claim 51, Manning modified by Maldonado, Reynolds and Contello discloses that the reflective flakes are embedded in the material (Column 5, Lines 42 – 48; Contello) and therefore are suspended in the material and also can be imprinted since embedding can just be an concavity in the surface of the material. Furthermore with respect to the act of imprinting; even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claims 117 and 120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldonado in view of Reynolds and Grande (U.S. 5,470,109)

In regards to Claims 117 and 120, as applied to Claims 115 and 118, Maldonado modified by Reynolds does not disclose wherein the elastomeric material attaching the top peripheral and bottom peripheral edges folds over the spine of the book when the book is inserted to the cover.

Grande discloses of a book cover having a binder locking feature wherein the portions of the cover are folded in and lock the spine into position (Column 5, Lines 26 – 34). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to having Maldonado's book cover to fold over the spine in order to lock the spine in position.

### ***Response to Arguments***

Applicant's arguments with respect to the pending have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./  
Examiner, Art Unit 3722  
March 19, 2008

/Monica S. Carter/  
Supervisory Patent Examiner, Art Unit 3722